

REMARKS

Reconsideration of this application in light of the amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1-31 are pending. Claims 1, 9-11, and 17-27 have been amended. No new matter has been added.

Finality of the July 14, 2006 Office Action

The Examiner has rejected claims 1-28 on the new ground of being directed to computer related non-statutory subject matter under 35 U.S.C. § 101. The Examiner contends that “Applicants’ amendments necessitated this new ground of rejection presented in the Office Action,” and has therefore made the July 14, 2006 Office Action final.

Applicants respectfully submit that the Examiner has improperly made this Action final. Section 706.07(a) of the MPEP states that “any subsequent actions on the merits shall be final, **except** where the examiner introduces a **new ground of rejection** that is **neither necessitated by the Applicants’ amendment of the claims** nor based on the information submitted in an information disclosure statement.” (emphasis added) Here, the Examiner’s newly presented ground of rejection under 35 U.S.C. § 101 was neither necessitated by the Applicants’ amendments nor based on information submitted in an information disclosure statement.

The rejection under 35 U.S.C. § 101 does not rely on any cited references disclosed by the Applicant, and therefore is not necessitated by any IDS submitted by the Applicant. The Examiner's new rejection of the claims as being directed to non-statutory subject matter contends that "since although it claims functional descriptive material in the form of a system for automatic content management, it is not recorded on a computer readable medium. Rather claim 1 is directed to software *per se*, and is therefore not statutory." (Office Action, item 4, pages 2-3.) However, the amendments presented in Applicants' April 12, 2006 Response to Non-Final Office Action, do not, in any way, remove the present invention from "a computer readable medium." Neither did Applicants' amendments strike any feature of the pending claims concerning recording on a computer readable medium. Therefore, assuming the Examiner's rejection under § 101 is correct, the rejection constitutes **a new grounds of rejection that was not necessitated by Applicants' amendments**. Therefore, the present Office Action can not be made final, because the new rejection under § 101 is within one of the exceptions identified in MPEP § 706.07(a).

Similarly, the Examiner has rejected claim 28 as being "directed to computer related nonstatutory subject matter, because it claims nonfunctional descriptive material, instead claiming abstract ideas, for example: comparing form data and generating data based on differences resulting from the comparing step." (Office Action, item 4, page 3.) Applicants submit that Applicants' April 12, 2006 Amendment did not alter claim 28 so as to only claim abstract ideas. Rather, if claim 28 is deemed nonstatutory because it claims abstract ideas and nonfunctional descriptive material, as the Examiner contends (a contention with which the Applicants strongly disagree), the rejection of claim 28 as directed to nonstatutory subject matter

should have been presented in the Examiner's first office action and is thus, not necessitated by Applicants' amendments. Therefore, the present Office Action can not be made final, because the new rejection under § 101 is within one of the exceptions identified in MPEP § 706.07(a).

Applicants respectfully request that the Examiner withdraw the finality of the present Office Action and re-issue the Office Action as non-final.

Rejection Under 35 U.S.C. § 101

Claims 1-28 stand rejected under 35 U.S.C. § 101 as being directed to computer related non-statutory subject matter.

The Examiner contends that claim 1 "claims functional descriptive material in the form of a system for automatic context management," but "it is not recorded on a computer readable medium. Rather, claim 1 is directed to software *per se*, and is therefore nonstatutory." (Office Action, item 4, pages 2-3 (*citing In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).)) In *Warmerdam*, the Court held that the claimed data structures were nonstatutory because they did not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. (MPEP § 2106 (IV)(B)(1)(a).) The MPEP further notes that "computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." (MPEP § 2106 (IV)(B)(1)(a).) However, "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which

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permit the computer program's functionality to be realized, and is thus statutory." (MPEP § 2106 (IV)(B)(1)(a).)

Claim 1 is directed to a "system for automatic context management for testing, monitoring and automating a network application." Claim 1 has been amended to recite "a computer having a CPU and a storage device; and a computer-readable medium encoded with a computer program configured to perform the steps" recited. Claim 1 further recites the steps of "parse said client side executable code," "recording at least one context-full test script," "providing a context-full API," and "replaying said context-full test script." The specification further discloses that "[t]he script can be recorded in any format that can be understood by the replay engine, e.g. plain text, XML, stored in a database, etc." (Specification, page 31, lines 1-2.) Thus, the recorder of claim 1 records the context-full script to a computer recordable medium (e.g., a plain text file, XML file, or a database). Therefore, claim 1 clearly recites a "computer program recited in conjunction with a physical structure, such as a computer memory," and should thus be treated as a statutory product claim under MPEP § 2106(IV)(B)(2)(a). (MPEP § 2106 (IV)(B)(1)(a).)

Claims 17-27 depend from claim 1 and have been similarly amended to recite a computer program "in conjunction with a physical structure, such as a computer memory." Thus, by virtue of their dependency from claim 1, and for the reasons discussed above with respect to claim 1, Applicants submit that claims 2-27 are directed toward statutory subject matter.

With respect to Claim 28, the Examiner contends that the claim is directed to nonfunctional descriptive material, and is directed to abstract ideas. "[C]ertain types of descriptive material, such as . . . mere arrangements or compilations of facts or data, are merely

stored so as to be read or outputted by a computer without creating any functional interrelationship . . . [and do] not impart functionality to either to the data as so structured or to the computer.” (MPEP § 2106 (IV)(B)(1)(b).) Such nonfunctional descriptive material should be considered non-statutory.

Claim 28 is directed to “a method of fuzzy form detection” and includes several steps or acts. The steps recited by claim 28 define functional interrelationships, and thus claim 28 is not directed, or limited, to “mere arrangements or compilations of facts or data” that could be properly categorized as nonfunctional descriptive material.

Furthermore, claim 28 does not claim abstract ideas, as the Examiner contends. For example, claim 28 recites the steps of “comparing a form to be submitted to at least one form in a session history; generating data based upon differences resulting from the comparing step; [and] performing said comparing and generating steps for each form in said session history.” Thus, claim 28 is specifically directed to comparing a form to be submitted with each form in a session history and generating data based upon those differences. Claim 28 does not abstractly recite comparing or generating data, but rather is specifically directed to comparing forms in a session history and generating data specific to those comparisons. Claim 28 further recites the steps of “choosing one of the forms in said session history having the greatest similarity to said form to be submitted based upon the generating step results; and applying form merging instructions to said chosen session history form to obtain a resulting form that is substantially identical to said form to be submitted.” As discussed above, these steps are specifically directed to forms in a session history and merging the contents of the most similar form in the session history with the form to be submitted according to merging instructions.

Thus, claim 28 does not claim abstract ideas, nor does it attempt to pre-empt substantially all practical applications of an abstract idea. Claim 28 is a practical application of comparing data, determining differences in data, and generating new data that is directed specifically to forms and form generation using the determined differences and merging instructions. Thus, claim 28 does not claim abstract ideas, and is therefore directed to statutory subject matter.

For at least the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-28 as being directed to non-statutory subject matter.

Rejection Under 35 U.S.C. § 112

Claims 9-12 stand “rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.” (Office Action, item 6, page 3.) The Examiner contends that claims 9-11 recite the phrase “each of said parser additions of said library of parser additions,” and the specification does not disclose a library of parser additions wherein *each* parser addition in the library of parser additions implements the algorithms as claims.” (Office Action, item 7, page 4.)

While Applicants disagree with the Examiner’s contention, in the interest of furthering prosecution, claims 9-11 have been amended to recite the phrase “wherein the at least one parser addition of said library of parser additions.” Support for this amendment and the recited claim language can be found in the Specification at page 21, lines 10-14, which recites, in relevant part, “[t]he parser addition 703 is used by the extensible document parser 702 to parse additional frames 721, embedded objects 722, hyperlinks 723 and forms 724.”

Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 112, ¶ 1.

Rejection Under 35 U.S.C. § 102

Claims 1-12 and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,549,944 to Weinberg et al. ("Weinberg").

Independent claim 1 is directed to "a system for automatic context management for testing, monitoring, and automating a network application having **client side executable code**" (emphasis added). Claim 1 further recites "a tool **operable to parse said client side executable code** so as to determine a subsequent state of the network application **free of interaction with a user**" (emphasis added). "Client-side code causes actions that are performed by the client, rather than by executing web application code on the server." (Specification, page 12, lines 17-18.)

The term "client side code execution" refers to code executed within the web browser by the client such as JavaScript code embedded in HTML documents or in separate JavaScript documents, Java applets, VBScript, ActiveX controls, or browser plug-ins. (Specification, page 11, lines 1-11.) "Code executed on the client side may dynamically assemble URLs and forms and cause page transitions using these URLs and forms. Such page transitions cannot be modeled by context-full replay instructions within a traditional page-level replay, because the URLs and forms may not correspond to any hyperlink or form contained in any previously downloaded web page." (Specification, page 11, lines 4-7.) Thus, the invention of claim 1 provides a system including a parser capable of parsing "standard and nonstandard embedded object, hyperlinks, and forms . . . embedded, for example, in JavaScript code in HTML documents or in java

applets.” (Specification, page 17, lines 10-12.)

Weinberg is directed to a visual web site analysis program having a “dynamic page scan feature [that] enables the user to include dynamically generated Web pages within the site map by capturing the output of a standard web browser when a form is submitted by the user, and then automatically resubmitting this output during subsequent mappings of the site.” (Weinberg, Abstract.) The Examiner contends that “Weinberg teaches that the testing tool has a Dynamic Scan feature for scanning dynamic HTML code, i.e., client side executable code, which may be set to automatically fill in dynamic forms without interaction from a user.” (Detailed Action, page 5, *citing* Column 23, line 15 - Column 26 line 19, especially col. 24, lines 1-33.)

Applicants respectfully submit that Weinberg does not disclose scanning client-side executable code, and further submit that automatically filling in forms is significantly different from client-side executable code.

Weinberg does not disclose “a tool operable to parse said client side executable code,” as recited by claim 1. Weinberg defines a dynamically generated webpage as “a page that is generated ‘on-the-fly’ by a Web site in response to some user input, such as a database query.” (Weinberg, column 23, lines 17-20 (*emphasis added*).) Weinberger does not mention or discuss dynamic HTML or dynamic forms. Thus, Weinberg is specifically limited to web pages that are created by software running on the server. Processing a form (e.g., an HTML form) does not require execution of client side code other than the web browser. In contrast, the invention recited by claim 1 parses “client side executable code” that can “dynamically assemble URLs and forms and cause page transitions using these URLs and forms,” and is not limited to dynamic content that is created by the server (i.e., web site).

Furthermore, Weinberg is limited to parsing standard HTML forms, completing those forms with previously collected data, and submitting the completed form as a standard HTTP request to the server. When a completed form is submitted to a web server, a particular URL, specified by the web server and coded within the web page containing the form, is requested and the data of the completed form is transmitted to the web server along with the URL request. By parsing client side executable code, the contents of a web page can be completely re-written by the client without any input from the server, other than the client side executable code. Thus, the claimed invention can dynamically generate URLs and forms, thereby significantly expanding the complexity of the network applications that can be tested, monitored and automated.

Claim 29 recites similar subject matter to that recited by claim 1. Thus, for at least the reasons discussed above with respect to claim 1, claim 29 is not anticipated by Weinberg.

Applicants respectfully request reconsideration and withdrawal of these rejections.

Rejection Under 35 U.S.C. § 103

Claims 13-28, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberg in view of U.S. Patent Publication No. 2002/0062342 to Sidles ("Sidles").

Claims 13-27 depend from claim 1 and recite their own features in addition to those of their base claim. Thus, claims 13-27, by virtue of their dependency from claim 1, recite those features demonstrated above to be missing from Weinberg with respect to claim 1. Applicants submit that Sidles does not disclose those features demonstrated to be missing from claim 1. Therefore, for at least the reasons discussed above with respect to claim 1, the combination of

Weinberg and Sidles does not disclose those features recited by claims 13-27, demonstrated to be missing from Weinberg with respect to claim 1.

With respect to claim 28, the Examiner contends that “Weinberg teaches a method of comparing a form being submitted to one form in a session history . . . using session history forms.” However, the Examiner relies on Sidles as teaching “a method of fuzzy form detection where a form is chosen from a database of forms which is similar to the form being submitted, and merged with past form data to produce a new filled form.” (Office Action, item 12, page 15.)

The Examiner contends that “Sidles teaches that the comparison and generating steps are preformed for each form in the session history, since all forms from the previous sessions are stored in the database for comparison against the submitted form.” (Office Action, item 12, page 15.) However, Applicants submit that Sidles does not disclose or suggest the same comparing, generating, choosing, and merging step as recited by the claimed invention.

Sidles discloses an automated form filling system that compares the **field names of the form** with the dictionary list of field names to see if it can find a match. If there is no exact match, fuzzy logic tries to “guess” how to fill the remaining data fields of the form (Sidles, paragraph 0040.) If the dictionary and fuzzy logic are unable to complete all the fields of the form, then the system looks in the history database to see if the specific site and form have been previously filled by a human person. (Sidles, paragraph 0041.) “[I]f the same form has been encountered and filled out previously . . . the form is filled out with user information using the previously entered information as a guide.” (Sidles, paragraph 0018.) Accordingly, Sidles does not generate “data based upon differences resulting from the comparing step” (i.e., the comparison of each form in the session history and the form to be submitted) as recited in claim

28. Rather, Sidles only generates data (i.e., fills out the form) if an exact match is found and does not generate data related to the differences between the forms.

Furthermore, Sidles does not disclose the step of “choosing one of the forms in said session history having the greatest similarity to said form to be submitted based upon the generating step results.” Sidles only chooses a form when an exact match is found. Moreover, the determination of the match is not based on data generated by the comparing step, but is based on an identical match.

Additionally, because Sidles lacks the generating step, Sidles also lacks “choosing one of the forms in said session history . . . based upon the generating step results,” as recited in claim 28. Furthermore, Sidles consequently lacks “applying form merging instructions to said chosen session history form,” as recited in claim 28.

For at least the reasons set forth above, Applicants submit that claim 28 is not obvious in view of the combination of Weinberg and Sidles.

Claims 30 and 31 recite similar subject matter to that recited by claim 1 and recite those features of claim 1 demonstrated to be missing from Weinberg. Additionally, Sidles does not disclose or suggest those features recited by claims 30 and 31 demonstrated to be missing from Weinberg with respect to claim 1. Thus, for at least the reasons discussed above with respect to claim 1, claims 30 and 31 are not obvious in view of the combination of Weinberg and Sidles.

Applicants respectfully request reconsideration and withdrawal of these rejections.

CONCLUSION

Each and every point raised in the Office Action dated July 14, 2006 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-31 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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